

REMARKS

In accordance with the foregoing, the specification and claims 1, 4, 10, and 19 have been amended.

Claims 1-34 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 112:

In the Office Action, at page 2, claims 10 and 19 were objected to because "type" in claim 10 is indefinite and "the identifier" in claim 19 lacks antecedent support. Claims 10 and 19 have been amended to improve clarity and antecedent support. It is respectfully requested that the rejections to the claims be withdrawn.

REJECTION UNDER 35 U.S.C. § 102:

In the Office Action, at page 3, claims 1-2, 4-7, 9, 14-17, 20-24, 26-28, and 30-34 were rejected under 35 U.S.C. § 102 in view of JP410138667A to Yamashina ("Yamashina"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested

According to Yamashina, as a recording medium, a CD-ROM is used, but a DVD may be used. Then, the information stored in the card 1 can be reproduced by using a cardholder. However, nothing in Yamashina teaches or suggest that the card 1 "receives a recording command from the recording and/or reproducing units **to record** the subject-related data stored in the recording and/or reproducing units from the subject," as recited in independent claim 1 or that the card 1 includes "a recording and/or reproducing unit **recording** and/or reproducing subject-related data **on**/stored in the trading card according to manipulation commands from the user," emphasis added, as recited in independent claim 4. Rather, the CD-ROM or the DVD can only request that the card 1 **reproduces** the information stored therein. Accordingly, it is respectfully requested that independent claims 1 and 4 and related dependent claim 2 be allowed.

Independent claim 5 recites, "a data storage unit in the trading card receiving a recording and/or reproducing command from the recording and/or reproducing unit to record the subject-related data stored in the recording and/or reproducing unit or receiving a reproduction

command from the recording and/or reproducing unit to reproduce the subject-related data stored in the data storage unit." The arguments previously presented supporting the patentability of the claimed features of the recording and/or reproducing apparatus are incorporated herein. Further, independent claim 5 recites, "the recording and/or reproducing unit processes and builds a message by implementing the user-related data into the subject-related data and displays and/or sound reproduces the message;" however, nothing in Yamashina teaches or suggests that the CD or DVD "builds a message by implementing the user-related data into the subject-related data and displays and/or sound reproduces the message," as recited in independent claim 5. Thus, it is respectfully requested that independent claim 5 be allowed.

Referring to independent claim 9, Yamashina describes, "a recording medium, a CD-ROM (compact disc read only memory) is used, but a DVD (digital video disk) may be used. Then the information stored in the card 1 can be reproduced by using a card holder." However, Yamashina fails to teach or suggest, "a recording and/or reproducing unit recording and/or reproducing subject-related data on/from the data storage unit, wherein the subject-related data comprises picture and/or text information related to the subject displayed on the trading card," as recited in independent claim 9. Nothing in Yamashina teaches or suggests that data may be on the card 1. Rather, the data may only be played from the card 1. Thus, Yamashina fails to teach or suggest all the claimed features of independent claim 9.

Independent claim 20 recites, "a recording and/or reproducing apparatus recording and/or reproducing subject-related data to/from the trading card." The arguments previously presented supporting the patentability of the claimed features of the recording and/or reproducing apparatus are incorporated herein. Thus, Yamashina fails to teach or suggest all the claimed features of independent claim 20 and related dependent claims.

Referring to independent claim 30, this claim recites, "recording the message in the trading card." Further, independent claim 32 recites, "building the message by implementing the user-related data into the subject-related data; storing the message in the trading card." However, as previously set forth, the CD or DVD provided in Yamashina can only request that the card 1 **reproduces** the information stored therein. Thus, Yamashina fails to teach or suggest all the claimed features of independent claims 30 and 32 and related dependent claims.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 4, claims 3, 18-19, and 29 were rejected under 35 U.S.C. § 103 in view of Yamashina and U.S. Patent No. 5,689,561 to Pace ("Pace"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Yamashina describes a trading card including a CD-ROM to store information, where the information may be reproduced by using a cardholder. Further, Pace describes a system where, instead of the prior art system of trading paper cards or the like, the user trades floppy disks to collect the collection items, and can enjoy audio/visual presentations and interactive computer games associated with the collected items. See abstract. However, the proposed modification of incorporating the description provided in Pace into Yamashina changes the principle of operation of Yamashina. In particular, Pace does not teach or suggest modifying a trading card to include a data storage unit and a housing unit "containing and protecting the data storage unit, wherein the housing unit comprises a serial number identifying the trading card," as recited in independent claim 3. Rather, Pace finds it limiting to use trading cards and accordingly describes a system where rather than trading cards; floppy disks are traded and used in combination with a computer system.

Even assuming, arguendo, that the description of Pace is included into Yamashina, the proposed combination would render Yamashina unsatisfactory for its intended purpose. Pace indicates that "instead of being contained on paper trading cards (or stamps or the like) as often found in the prior art, the collectible items of the present invention are contained on standard 3 1/2" floppy disks." See column 1, lines 43-50 of Pace. Further, according to MPEP 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Further, the motivation provided in the Office Action to combine the references is "to prevent unauthorized copy or duplication of the disks to further ensure that the disk is original manufactured." However, nothing in either reference suggests or supports the purported combination of the references set forth in the Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. "To support the conclusion that the claimed combination is directed to obvious subject matter, either

the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

Accordingly, in view of the foregoing, it is respectfully asserted that the prima facie obviousness rejection fails on its face and, accordingly, the combination of the references cited fails to teach or suggest a trading card comprising "a housing unit containing and protecting the data storage unit, wherein the housing unit comprises a serial number identifying the trading card," as recited in independent claim 3.

Because claims 18-19 depend from independent claim 9, the claimed features of independent claim 9 must be shown in Yamashina and/or Pace. The arguments presented above supporting the patentability of independent claim 9 in view of Yamashina are incorporated herein. Further, as previously set forth, Pace fails to teach or suggest, "a recording and/or reproducing unit recording and/or reproducing subject-related data on/from the data storage unit, wherein the subject-related data comprises picture and/or text information related to the subject displayed on the trading card," as recited in independent claim 9. Pace teaches away from providing a combination of a trading card, a data storage unit, a recording and/or reproducing unit, and a housing unit. Rather, Pace provides a computer and a collection of floppy disks. Thus, even assuming, arguendo, that Yamashina and Pace were combined, the combination would be silent as to providing the claimed features of the recording and/or reproducing unit recited in independent claim 9. Accordingly, it is respectfully requested that independent claim 9 and related dependent claims be allowed.

Referring to independent claim 29, this claim recites, "loading trading cards into a magazine; processing subject-related data stored in the trading cards." However, Yamashina and Pace, individually or combined, are silent as to teaching or suggesting that the trading card may be loaded into a magazine. Further, the cited references, as previously discussed, fail to teach or suggest, "transmitting the subject-related data to a recording and/or reproducing apparatus, wherein the subject-related data comprises moving pictures arranged in a sequence using serial numbers; and processing the serial numbers to sequentially reproduce the moving pictures via a display unit." Accordingly, it is respectfully requested that independent claim 29 be allowed.

In the Office Action, at page 5, claim 8 was rejected under 35 U.S.C. § 103 in view of Yamashina and U.S. Patent No. 5,956,877 to Raasch ("Raasch"). The reasons for the rejection

are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The Office Action correctly recognized that Yamashina fails to teach or suggest, "a magazine loading trading cards, processing subject-related data stored in the trading cards, and transmitting the subject-related data, wherein the subject-related data comprises moving pictures arranged in a sequence using serial numbers," as recited in independent claim 8. Further, as previously discussed, Yamashina further fails to teach or suggest, "a recording and/or reproducing apparatus receiving the subject-related data and processing the serial numbers to sequentially reproduce the moving pictures via a display unit," as recited in independent claim 8.

Raasch, in turn, describes collectible display devices including a ticket window of sufficient size to exhibit sprocket holes of the film frame or clip for authenticity. See abstract and column 1, lines 8-20 of Raasch. However, similarly to Yamashina, Raasch fails to teach or suggest "receiving the subject-related data and processing the serial numbers to sequentially reproduce the moving pictures via a display unit," as recited in independent claim 8. Raasch limits its description to displaying a frame or clip of a film. Nothing in Yamashina or Raasch teaches or suggests "a magazine loading trading cards" where the magazines process "subject-related data stored in the trading cards, wherein the subject-related data comprises moving pictures arranged in a sequence using serial numbers," as recited in independent claim 8. Further, the cited references, individually or combined, fail to teach or suggest the claimed features of the recording and/or reproducing apparatus of independent claim 8.

Furthermore, as commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... "[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84. However, the Examiner has provided absolutely no motivation to combine the cited references. Rather, conclusive statements are made such as "it would have been obvious to an artisan of ordinary skill in the art . . . to incorporate moving pictures arranged in sequence using serial number as taught by Raasch to the teaching of Yamashina in order to keep track of the pictures/images by their serial number to further provide a capability to display

a desired picture/image instantly by its serial number or to sequentially display the pictures/images on the display unit."

"Rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to generate a combination of Yamashina and Raasch, as set forth in the Office Action, to disclose the presently claimed invention. Applicants respectfully assert that the prima facie burden has not been met.

In the Office Action, at page 6, claims 10-13 were rejected under 35 U.S.C. § 103 in view of Yamashina and U.S. 2002/0052238 to Muroi ("Muroi"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Because claims 10-13 depend from independent claim 9, Yamashina and Muroi, individually or combined, must teach all the claimed features of independent claim 9. The arguments presented above supporting the patentability of independent claim 9 in view of Yamashina are incorporated herein. Referring to Muroi, this reference provides that with trading cards, various pictures, patterns, designs and other information are printed in a fixed hard-copy form and thus cannot be varied at all. See paragraph [0003] of Muroi. Thus, Muroi provides an electronic game system, which, in accordance with progression of a game, can variously rewrite data recorded on a trading card. See paragraphs [0004] and [0005] of Muroi. However, Muroi fails to teach or suggest, "a trading card with a subject printed thereon;. . . a recording and/or reproducing unit recording and/or reproducing subject-related data on/from the data storage unit, wherein the subject-related data comprises picture and/or text information related to the subject

displayed on the trading card," as recited in independent claim 9. Accordingly, even if Yamashina and Muroi were combined, all the claimed features recited in independent claim 9 would not be provided. Accordingly, it is respectfully requested that independent claim 9 and related dependent claims be allowed.

In the Office Action, at page 6, claim 25 rejected under 35 U.S.C. § 103 in view of Yamashina and JP 406215010 to Tsutsui ("Tsutsui"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Because claim 25 depends from independent claim 20, Yamashina and Tsutsui, individually or combined, must teach all the claimed features of independent claim 20. Tsutsui describes an information recording device storing information input through an information input section into a temporary recording section thereafter to record a recording medium comprised of a plurality of recording medium pieces, thereby making it possible to correctly record information at a high speed even in the case where a recording medium having relatively low write speed is employed. However, Tsutsui fails to teach or suggest that the information recording device records and/or reproduces "subject-related data comprises picture information related to a subject," as recited in independent claim 20. Yamashina and Tsutsui, individually or combined, fail to teach or suggest a recording and/or reproducing unit "transmitting subject-related data to and receiving the subject-related data from the trading card," as recited in independent claim 20. Yamashina and Tsutsui fail to transmit subject-related data to the trading card. Further, neither reference teaches or suggests, "a key controller inputting manipulation commands by a user," as recited in independent claim 20. Thus, even assuming, arguendo, that both references were combined, all the claimed features of independent claim 20 would not be provided.

Further, Applicants respectfully assert that the Office Action has failed to present evidence in Tsutsui and/or Yamashina providing motivation, or suggestion to select and combine the references. As pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to generate a combination of Yamashina and Tsutsui, as

set forth in the Office Action, to disclose the presently claimed invention. Applicants respectfully assert that the prima facie burden has not been met.

Accordingly, it is respectfully requested that independent claim 20 and related dependent claims be allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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